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APPLICATION NO.		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/735,322		12/12/2003	Chih-Lung Chang	3304.2.101	6011	
21552	7590	02/04/2005		EXAM	EXAMINER	
MADSON	& MET	CALF	LORENGO	LORENGO, JERRY A		
GATEWAY SUITE 900	TOWE	R WEST	ART UNIT	PAPER NUMBER		
15 WEST S	OUTH T	EMPLE	1734			
SALT LAK	E CITY,	UT 84101	DATE MAILED: 02/04/2005			

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/735,322	CHANG ET AL.					
Office Action Summary	Examiner	Art Unit					
	Jerry A. Lorengo	1734					
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the o	correspondence address					
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a repl If NO period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailin earned patent term adjustment. See 37 CFR 1.704(b).	136(a). In no event, however, may a reply be tir ly within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from a, cause the application to become ABANDONE	nely filed s will be considered timely. I the mailing date of this communication. D (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on							
	 s action is non-final.						
3) Since this application is in condition for allowa	Since this application is in condition for allowance except for formal matters, prosecution as to the ments is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
Disposition of Claims							
4) ⊠ Claim(s) 1-11 is/are pending in the application 4a) Of the above claim(s) is/are withdra 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) 1-11 are subject to restriction and/or	wn from consideration.						
Application Papers							
9)☐ The specification is objected to by the Examine	er.						
10) ☐ The drawing(s) filed on is/are: a) ☐ acc	) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the	drawing(s) be held in abeyance. Se	e 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex	•	•					
Priority under 35 U.S.C. § 119		,					
12) ☑ Acknowledgment is made of a claim for foreign a) ☑ All b) ☐ Some * c) ☐ None of:  1. ☑ Certified copies of the priority document 2. ☐ Certified copies of the priority document 3. ☐ Copies of the certified copies of the priority application from the International Burear * See the attached detailed Office action for a list	ts have been received. Is have been received in Applicat Inity documents have been receive In (PCT Rule 17.2(a)).	ion No ed in this National Stage					
Attachment(s)							
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail D  5) Notice of Informal F  6) Other:						

Application/Control Number: 10/735,322

Art Unit: 1734

## **DETAILED ACTION**

(1)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method for applying an image onto an article having a light transmissible surface, classified in class 156, subclass 230.
- II. Claims 6-11, drawn to a use of an image-transfer medium, classified in class 156, subclass 235.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination, respectively. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the article have a light transmissible surface. The subcombination has separate utility such as forming decorative patterns on light transmissible substrates such as windows, light boxes, view screens, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Evan Witt on February 2, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made as Mr. Witt requested that the Examiner issue the restriction requirement as a written communication.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Application/Control Number: 10/735,322 Page 3

Art Unit: 1734

(2)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lorengo, Primary Examiner

AU 1734 / Rebruary 2, 2005